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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,783	02/04/2004	Freeman Lewis Farrow	124188-00001	5156

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EXAMINER

MAY, ROBERT J

ART UNIT PAPER NUMBER

2875

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,783

Applicant(s)

FARROW ET AL.

Examiner

Robert May

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 8, 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's argument filed 2 November 2005 on Page 5 regarding Claim 1 rejected under 35 U.S.C 112, second paragraph has been fully considered and the amendment to Claim 1 has addressed the omitted structural cooperative relationship between the light and the vehicle enabling the light to pivot.

Applicant's arguments filed 2 November 2005 on Page 5 regarding Claims 1, & 7-9 have been fully considered but they are not persuasive. Claim 1 recites the light pivoting directly in response to the pull of gravity, but the examiner maintains the rejection over Tajima because Tajima discloses the light as rotating directly in response to gravitational forces (i.e. speed and turning radius) and the examiner interprets this as a direct response to gravity even if a separate mechanism such as a gyroscope is used.

It is suggested by the Examiner to use a negative limitation per MPEP 2173.05(i) in defining the light assembly excluding such mechanisms as a gyroscope, sensor, solenoid, etc., as disclosed in the specification on page 6, if the applicant wishes to assertively exclude such mechanisms in Claim 1.

Applicant's arguments filed 2 November 2005 on Page 6 regarding Claim 11 has been fully considered but they are not persuasive for the same reasons stated above.

Applicant's arguments filed 2 November 2005 on Page 6 regarding Claims 2,3,5, & 8 have been fully considered but they are not persuasive for the same reasons stated above.

Applicant's arguments filed 2 November 2005 on Page 7 regarding Claims 4 & 6 have been fully considered but they are not persuasive for the same reasons stated above.

Applicant's arguments filed 2 November 2005 on Page 6 regarding Claim 8 have been fully considered but are not persuasive for the same reasons stated above but would be allowable if written in independent form as stated below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Amended Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. Claim 1 fails to assertively claim the "connector" as being attached to the vehicle but only as being adapted to be attached to the vehicle. Furthermore, Claim 1 fails to assertively claim the light as being connected in some way to the bracket connector assembly but simply infers this when it is recited that the light pivots in response to the pull of gravity when the vehicle leans.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 & 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima (JP62096148). Tajima discloses a light for a motorcycle, a connector that attaches the light to the vehicle in which the light pivots or rotates in a direction reverse to the inclination of the motorcycle body in response to the speed and turning radius.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 2-3, 5, 7 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima as applied to Claim 1 and further in view of Funabashi (US Pat. 4,356,536).

Regarding Claims 2-3 & 5, Tajima does not disclose a C Bracket with side flanges forming a C-shape with a bolt rotatable with respect with the vehicle that extends through the bracket with a nut and washer engaging the bolt to secure the bolt to the bracket.

Regarding Claim 7, Tajimi does not explicitly disclose the light assembly as being a vertical cut-off light

Regarding Claim 12, Tajimi does not explicitly disclose the light assembly as being pivotable about a horizontal axis with respect to the vehicle.

Regarding Claims 2-3 5, & 7 & 12 Funabashi discloses in Figure 5, a C-shaped bracket 5 with side flanges (5a) for holding a light and a threaded shaft or bolt (10) with nut and washer (not labeled in Fig 5) for securing the bracket to the bolt (not labeled), which rotates, with the light bracket (Col. 3, Lines 5-9). This is to enable adjustment of the headlight beam relative to the vehicle body along a horizontal and vertical plane (Col. 3, Lines 40-43), which is construed by the office to be a vertical cut-off light. Therefore, it would be obvious to one of ordinary skill to modify the light apparatus of Tajimi with the C-Bracket bolt washer assembly of Funabashi so that the light can be adjusted along a horizontal and vertical plane.

Claims 4 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima in view of Funabashi as applied to claims 2-3, & 5 above, and further in view of Carlson (US Pat. 1,543,150).

In regard to Claim 4, Tajima in view of Funabashi does not disclose a hollow bolt with wiring disposed within electrically connecting the light to the source of electricity. However, Carlson discloses in Fig 3, a threaded hollow post (9) with light wire 25 led within from the light through to the battery. This would reduce the external exposure of wires of a rotting system secured by a bolt like connection mechanism. Also, Therefore, it would be obvious to modify the teachings of Tajima in view of Funabashi with the threaded hollow post of Carlson in order to have a rotating assembly that does not exposed wires to the outside environment, which could potentially damage the wires.

In regard to Claim 6, Tajima in view of Funabashi does not explicitly disclose a bearing, however the joint between the post (9) and the standard (14) acts as a support for a rotating member and is construed by the office to be a bearing assembly. This allows the light support to rotate with respect to the vehicle body. Therefore, it would be obvious to one of ordinary skill in the art to modify the light of Tajima in view of Funabashi with the hollow post and bearing assembly of Carlson in order to allow the motorcycle headlight rotate with respect to the vehicle body.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima. Tajima discloses the claimed invention except for left and right lights. It would have

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been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the disclosed single headlight of Tajima, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (CA7 1977). Therefore, it would be obvious to one ordinary skill in the art to duplicate or make plural the single headlight of Tajima, because it involves only routine skills in the art.

Allowable Subject Matter

Claims 8 & 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance:

Regarding Claim 8, the prior art does not teach or suggest a bearing assembly that operatively connects the bolt to the connector and the bolt is rigidly connected to the attachment bracket so that the bolt rotates with respect to the connector.

Regarding Claim 10, the prior art does not teach or suggest a connector that is L shaped for connecting the light to the body of the vehicle.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert May whose telephone number is (571) 272-5919. The examiner can normally be reached between 9 am– 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax number for the

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organization where this application or proceeding is assigned is (571) 273-8300 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM

1/3/2006

A handwritten signature in black ink, appearing to read 'JAW', is positioned above the printed name.

**JOHN ANTHONY WARD
PRIMARY EXAMINER**